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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/037,143

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Jay S. Walker

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EXAMINER

VAN BRAMER, JOHN W

ART UNIT

PAPER NUMBER

3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/037,143	Applicant(s) WALKER ET AL.	
	Examiner John Van Bramer	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 3, 4, 7-15, and 17-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 3 16, 19, 23 and 29 of U.S. Patent No. 6,327,573. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A reward method comprising:

- a. Retrieving a customer record in response to an account identifier, including frequent shopper data.
- b. Identifying whether a sub-account holder is present. (Physically present based upon reason for allowance provided by the examiner of U.S. Patent No. 6,327,573). And the physical presence information includes data from an input device, credit card data, license plate data etc.
- c. Transacting with a primary account holder and a sub-account holder, based on transaction rules and presence rules.
- d. Determining a reward level
- e. Allocating the determined reward level, including at least adding or increasing reward points.
- f. Updating the retrieved customer record.

Claim Rejections - 35 USC § 112

3. Claims 3-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites that transaction data is received. This transaction data must contain some type of account number, or a customer identification means because a customer record is retrieved based on the transaction data. The applicant indicates in Claim 4 that frequent shopper data (which might contains the necessary customer

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identification means) is narrower in scope than the broader transaction data claimed in Claim 3. Therefore, One of ordinary skill in the art would expect that the transaction data received is another form of identification such as typed data, voice data, biometric data, audio-spatial data, voice recognition data, handwriting recognition data, fingerprint data, retinal data, a credit card, smart card data, data from a touch screen or data from an input device. Once the transaction data (credit card?) is received, account information is retrieved and a step of determining the presence of both a primary account holder and a sub account holder is claimed. The applicant claims that this presence information is to include typed data, voice data, biometric data, audio-spatial data, voice recognition data, handwriting recognition data, fingerprint data, retinal data, a credit card, smart card data, data from a touch screen or data from an input device. However, since the transacting customer has already supplied this presence information then the presence of either the primary account holder or the sub account has already been determined. The examiner is unclear as to whether the claim intends for; the customer to submit two separate forms of identification; the customer to submit the same type of identification twice (once for transaction data and once for presence determination), or the submission of the transaction data is intended to suffice for the presence of the primary account holder and the determination step is intended to ensure that a sub account holder is also present in order to enable the determination and allocation of the award. Additionally, Dependent claim indicates that the term "presence" be broader than the term "physical presence". The examiner is unsure

whether the mere existence of a sub account holder in a database constitutes “presence” or whether the sub account holder must be physically present.

Independent claims 14 and 23 suffer from the same indefinite nature, as do dependent claims 4-13, 15-22, and 24-27 by virtue of their dependency on independent claims 3, 14, and 23.

Therefore, the examiner is using the following interpretation of independent claims 3, 14, and 23 when prosecuting the application:

A method, computer readable medium, and a system configured to:

- a. Receive transaction data, including presence information from a primary account holder.
- b. Retrieve a customer record based on said transaction data, the customer record including account information identifying the primary account holder and at least one sub-account holder.
- c. Determining that at least one sub account holder is also present in the database.
- d. Transacting with the present primary account holder and the present sub account holders.
- e. Determining a reward.
- f. Allocating the reward, according to at least one rule, to the primary account holder and the sub account holders that are determined to be present.

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4. Claims 5, 6, and 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 3, requires that both primary account holder and the sub account holder to be present. However, Claims 5, 6, and 16 all attempt to broaden the scope of the claim to include events that occur when the primary account holder is not present.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 3-6, 11, 12, 14-16, 20, 21, 23, 24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanter (U.S. Patent Number: 5,537,314).

Claims 3-6, 14-16, 23, and 26: Kanter disclose a method, computer medium, and system consisting of:

- a. Receiving transaction data associated with a customer transaction. (Page 21, lines 9-52) (Kanter discloses the rewarding of participants for making individual sales as well as signing up additional participant. When a sale is made, the selling participants account number is retrieved, this number includes the sub account information containing the account number of the participant's sponsor.)

- b. Retrieving a customer record based on the transaction data, the customer record including account information identifying a primary account holder and at least one sub-account holder. (Page 21, lines 9-52) (Kanter discloses the rewarding of participants for making individual sales as well as signing up additional participant. When a sale is made, the selling participants account number is retrieved, this number includes the sub account information containing the account number of the participant's sponsor.)
- c. Determining that at least one of the primary account holder and at least one of the sub account holders is present. (page 21, lines 9-52)(Verifying that a participant has a sponsor that is present in a database, and rewarding said sponsor for sales of the participant.)
- d. Transacting with at least one of a present primary account holder and a present sub account holder. (Page 21, lines 9-52)(Paying commissions to both the participant and the participant's sponsor)
- e. Determining a reward. (Page 21, lines 9-52) (Reward levels are determined by sales volume which is frequency data.)
- f. Allocating the reward according to at least one rule to at least one of a primary account holder and any sub-account holders determined to be present. (Page 21, lines 9-52) (After determining reward levels, the respective commissions are allocated to the participant and their sponsor's accounts, thereby updating the respective accounts)

Claims 11 and 20: Kanter discloses the method of claim 3, wherein the reward comprises at least one of an immediate discount associated with the transaction, an increase in reward points, a future discount, a coupon, and a monetary rebate.

(Page 21, lines 9-52) (The reward levels are monetary.)

Claims 12, 21, and 24: Kanter discloses the method of claim 3, wherein the at least one rule comprises at least one of transaction rules, reward rules, physical presence rules, and affiliation rules. (Page 21, lines 9-52) (Since a sale must be made a transaction rule is disclosed as an award rule.)

Allowable Subject Matter

7. Claims 7-10, 13, 17-19, 22 and 25 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Each of these claims would provide the limitation that both the primary account holder and the sub account holder be physically present during the transaction and thus overcome the prior art.

Response to Arguments

8. Applicant's arguments filed December 22, 2006 have been fully considered but they are not persuasive. All previously submitted claims have been cancelled

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and thus all arguments are directed to only those claims that have been newly submitted.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

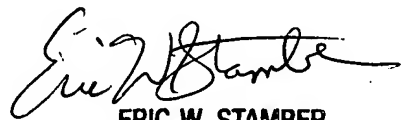
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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